

REMARKS

Claims 1-5, 10-16 and 19-27 are pending. Claims 6-9 and 17-18 have been canceled without prejudice.

[I] Prior art based issues

The sole remaining rejection is that of claims 12-16 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ishisuka et al. (U.S. Patent 6,140,038) and Bojora et al. (U.S. Patent 3,667,959). Applicants respectfully traverse the rejection.

Applicants note that Ishisuka et al. is assigned to Fuji Photo Film Co., Ltd., and is available under 35 U.S.C. § 103(a) based on 35 U.S.C. § 102(e).

[I- A] Issues under 35 U.S.C. § 103(a) based on 35 U.S.C. § 102(e)

In order to overcome this rejection, Applicants take advantage of the safe harbor of 35 U.S.C. § 103(c). According to MPEP § 706.02(l)(1), subject matter which was prior art under 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made" owned by the same person or subject to an obligation of assignment to the same person."

MPEP § 706.02(l)(2) instructs that an attorney or agent of record may make a statement to the effect that that application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

[I-A-i] Statement Evidencing Common Ownership

The presently claimed invention and the subject matter of U.S. Patent to Ishisuka et al. were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

[I-A-ii] Consequences Of The Above-Statement

Accordingly, Applicant respectfully submits that the reference, Ishisuka et al. is not available as prior art under 35 U.S.C. § 102(e)/§ 103(c).

In order to take advantage of 35 U.S.C. § 103(c), we need to make a statement that the present invention and the subject matter of Ishisuka et al. were commonly owned at the time of the invention. As your Attorneys, we can make this statement for you. By making this statement, the rejection under 35 U.S.C. § 103/102(e) can be overcome. Do you give us permission to make this statement for you?

As a side note, the Examiner is respectfully made aware that Ishisuka et al. is in the same patent family as JP 2000/029163 (JP '163) which published on January 28, 2000. JP '163 is available under 35 U.S.C. § 103 based on 35 U.S.C. § 102(a). Attached is a copy of JP '163 and a PTO SB-08 form listing JP '163. The Examiner is requested to make it clear on the record, preferably by signing and initialing the attached PTO SB-08 form, that the Examiner has considered JP '163.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., Reg. No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/643,221
Amendment dated September 5, 2008
Reply to Office Action dated March 7, 2008

Docket No.: 2870-0264P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By  #43575
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Attached: JP 2000/029163 and a PTO SB-08 form listing JP 2000/029163